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Date: December 13, 2005
From: James B. Conte
To: Office of Petitions
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MESSAGE:

Re: Berton L. Vicars
10/764,902
Our File No.: 926512-95493

CONFIDENTIALITY NOTE

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DEC 13 2005

Docket No. 926512-95493

CUSTOMER NO. 23644

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE THE APPLICATION OF
Berton L. Vicars

Examiner:

SERIAL NO: 10/764,902

Confirmation No.: 2637

FILED: January 26, 2004

FOR: Suction Valve

Mail Stop - Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

- ☒ **AUTHORIZATION TO PAY AND PETITION FOR THE ACCEPTANCE OF ANY NECESSARY FEES.** If any charges or fees must be paid in connection with the following Communication (including but not limited to the payment of Issue Fees), they may be paid out of our deposit account 12-0913. If this payment also requires a Petition, please construe this authorization to pay as the necessary Petition which is required to accompany this payment.
- ☐ Applicant hereby petitions for a _____-month extension and entry of this Amendment which is sent within the _____ month after the due date of _____. The payment of \$_____ to cover the _____ month extension is enclosed herewith.

**RESPONSE TO DENIAL OF PETITION TO WITHDRAW HOLDING OF
ABANDONMENT BASED ON FAILURE TO RECEIVE AN OFFICE ACTION
OR IN THE ALTERNATIVE
PETITION TO REVIVE BASED ON UNINTENTIONAL ABANDONMENT**

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being facsimile transmitted to: Attn: Office of Petitions at facsimile number 571-273-8300 on:

Date: December 13, 2005

By:

Donna B. Vandenberg

**BARNES & THORNBURG
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CHICAGO, ILLINOIS 60690-2786
(312) 357-1313**

Applicant received a communication from the Patent Office mailed November 16, 2005 denying its petition to withdraw the holding of abandonment.. Applicant believes that the denial is inappropriate.

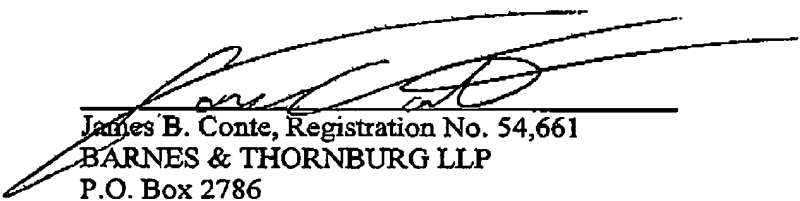
The Communication dismissing the Petition indicates that Applicant practices at a P.O. Box different from the P.O. box of record. Applicant does practice at P.O. Box "2786". The P.O. Box of record is "2798". The fact that the Patent Office has a different P.O. Box than the one Applicant practices at does not justify denying the Petition. Applicant obviously, when it filed the case erroneously included the wrong P.O. Box. Applicant did not notice the problem because all of the communications directed to the erroneous P.O. Box 2798, excepting the Final Office Action, made it to Applicant. Indeed, the Notice of Abandonment made it to Applicant and the present Notice dismissing Applicant's Petition made it to Applicant. What is clear is that the Patent Office was advised by the Post Office that it had the wrong P.O. Box. PAIR indicates that the Final Office Action, never received by Applicant, was indeed returned to the Patent Office. Accordingly, the Patent Office could have examined the file. An examination of the file would have revealed that Applicant's practitioner was at the P.O. Box 2786. Indeed, the application transmittal included P.O. Box "2786".

Importantly, the rules do not require that Applicant establish that the Patent Office had the right correspondence address to obtain a withdrawal of abandonment. Applicant, as noted in the Decision need only show that it did not receive the Action. All of the evidence of record makes it clear that it did not receive the Action. It did not receive the Action because the Action was sent to the wrong P.O. Box; the Action was not forwarded to Applicant. The sole issue before the Patent Office in considering the withdrawal of abandonment is whether Applicant has established that it did not receive the Office Action. Applicant clearly did not receive the Office Action.

The above clearly states that the abandonment was unintentional, and that applicant did not intend to delay revival of the case. A copy of the response to the Office Action mailed 12/01/2004 is enclosed. The only requirement of the Action was to submit a terminal disclaimer. Applicant, for its response, submits the terminal disclaimer. The PTO may debit Deposit Account 12-0913 for all fees needed to revive. A change of correspondence address has been filed.

Respectfully submitted,

Tuesday, December 13, 2005



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CHDS01 /CONTE 308515v1